



AUG 15 2001

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Dr. Jim Considine
Exten Industries
9625 Black Mountain Road, Suite 218
San Diego, CA 92126-4564

In re Application of	:	
MYERS, et al.	:	
Application No.: 08/809,677	:	DECISION ON PETITION
PCT No.: PCT/US94/10935	:	
Int. Filing Date: 27 September 1994	:	UNDER 37 CFR 1.47(b)
Priority Date: 27 September 1994	:	
Attorney Docket No.: 07354/004001	:	
For: ARTIFICIAL LIVER APPARATUS AND	:	
METHOD	:	

This is a decision on applicant's "Petition Under 37 C.F.R. §1.47" filed in the United States Patent and Trademark Office (USPTO) on 04 June 2001 and again on 17 July 2001. The petition fee of \$130.00 (37 CFR 1.17(h)) has been included.

BACKGROUND

On 07 March 2001, applicant was mailed a decision in which applicant's petition under 37 CFR 1.137(b) was dismissed as moot as a previously mailed "NOTIFICATION OF A DEFECTIVE RESPONSE" (Form PCT/DO/EO/916) was mailed to the wrong address. The NOTIFICATION OF ABANDONMENT" (Form PCT/DO/EO/909) mailed 12 June 2000 was hereby **VACATED**.

On 30 April 2001, applicant was mailed a "Notification of a Defective Response" informing applicant of the need to file an executed declaration in compliance with 37 CFR 1.497. Applicant was given one month to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 04 June 2001, applicant responded with the present petition under 37 CFR 1.47(b).

DISCUSSION

cannot be reached after diligent effort; (3) a statement of the last known address of the signing inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of, and as an agent for the non-signing inventor; (5) proof of proprietary interest in the application; and (6) any other action that such action is necessary to preserve the rights of the parties or to prevent

irreparable damages. With the filing of the present petition and papers, applicant has satisfied items (1) and (3).

As to item (2), as stated in the Manual of Patent Examination Procedure (MPEP), Section 409.03(d) Proof of Unavailability or Refusal, "Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature." Applicants have not shown that a *bona fide* attempt was made to present the application papers, including the specification, claims, and drawings to inventors Myers, Li and Demetriou. The mere anticipation that the inventors will refuse to execute an oath or declaration in the future is insufficient. In order to proceed pursuant to 37 CFR 1.47(b) applicant must show an actual refusal by the non-signing inventor to execute the declaration or silence on the part of the non-signing inventor after a complete set of application papers have been presented to him.

As to Item (4), applicant did not provide an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as an agent for the non-signing inventors.

Regarding Items (5) and (6), applicant has failed to show proof of proprietary interest in the application or that proceeding without an executed declaration from Drs. Myers, Li and Demetriou is necessary to preserve the rights of the parties or to prevent irreparable damages. As discussed in the decision mailed 07 March 2001, the purported assignment has not furnished sufficient proof that "Xenogenics Industries" owns the entire interest. The recorded assignment refers to "Exten Industries" and has only been signed by one of the three named inventors, Dr. Myers. The assignment agreement signed on 26 October 1992 by Myers to CSMC does not appear to be directed to the present invention. Also, Dr. Li's employment agreement does not state that he is obligated to assign his invention to Xenogenics. In paragraph 2.13 references are made to an appendix B which is not attached. Lastly, Mr. Demetriou has signed an assignment to Exten, however, this execution occurred later than the assignment from Exten to Xenogenics.

For the above reasons, it would not be appropriate to accept this application without the signatures of Drs. Myers, Li and Demetriou.

CONCLUSION

The petition filed under 37 CFR 1.47(b) is **DISMISSED**, without prejudice.

If further prosecution on the merits of this petition is desired, a proper response must be filed within the time period specified in the notice of abandonment. If the petition is not successful, a petition fee is required.

Should status under 37 CFR 1.47(b) not be successfully completed, the international application will be viewed as having become abandoned with respect to the United States of

America at midnight at the expiration of the time period set in this decision or as extended by any extension fee timely paid under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter directed to the attention of the PCT Legal Office.

Leonard Smith
Legal Examiner
PCT Legal Office

Derek A. Putonen
Petitions Attorney
PCT Legal Office
Tel: (703) 305-0130
Fax: (703) 308-6459